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EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/740,200

Applicant(s)

MCHUGH ET AL.

Examiner

Salad E Abdullahi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **Response**

1. After further reviewing claims 1-40, the examiner has withdrawn restriction requirement issued on 6/15/2004. Hence, claims 1-40 will be examined in this office action. Examiner apologizes for any burden bears to the applicant.
2. This application has been reviewed. Original claims 1-40 are pending. The rejection cited stated below.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-19, 25-32, and 35-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Markus U. S. Patent No. 6,499,042[hereinafter Markus].

As per claim 1, Markus discloses a method of transferring data relating to a user from a first data processing device (15) to a second data processing device (14) over a communications network, said method comprising the steps of:

a) said first device (form-filling server or selective proxy) receiving over said network from said second device (form-originating server) a request for said data, said request including an identification of one or more pre-defined data elements for which the request is made (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);

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b) said first device accessing a file containing data relating to the user, said file including data elements identified by data element identifiers and retrieving from said file one or more of said data elements identified in said request (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64); and

c) said first device forwarding to said second device said retrieved data elements (see col. 3, lines 43-47).

As per claim 2, Markus discloses a method according to claim 1 wherein one or both of said devices are computers (see fig. 3).

As per claim 3, Markus discloses a method according to claim 1, wherein said file is stored on said first device (see col. 3, lines 37-52).

As per claim 4, Markus discloses a method according to claim 1, wherein said request is in the form of a web page having one or more fields for receiving data elements, and wherein said identification of one or more pre-defined data elements is in the form of a machine-readable tag accompanying said one or more fields (see col. 3, lines 20-64).

As per claim 5, Markus discloses the a method according to claim 4, wherein said first device retrieves from said data file those data elements having identifiers which correspond to the tags in the request (see col. 3, lines 20-64).

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As per claim 6, Markus discloses a method according to claim 5, wherein a browser engine (document browser)) operating on said first device adds said retrieved data elements to said web page and presents the web page including the added data elements to a user before forwarding said data elements to said second device (see col. 3, lines 20-24).

As per claim 7, Markus discloses a method according to claim 6, wherein said browser engine provides the user with the option to confirm the submission of said data elements before forwarding said data elements to said second device (see col. 2, lines 13-17).

As per claim 8, Markus discloses a method according to claim 6, wherein said browser engine provides the user with the option to vary said data elements before forwarding said data elements to said second device (see col. 2, lines 13-17).

As per claim 9, Markus discloses a method according to claim 1, further comprising the step of said first device logging the submission of said data elements to said second device (see col. 3, lines 49-52).

As per claim 10, Markus discloses a method according to claim 1, wherein said first device is a server (proxy server) which stores said data on behalf of said user (see col. 1, lines 31-40).

As per claim 11, Markus discloses a method according to claim 10, further comprising the step of verifying with said user that the data should be forwarded to said second device (see col. 2, lines 13-17).

As per claim 12, Markus discloses the method according to claim 11, wherein said user is connected to said network by a device which is physically remote from said first device (see fig.2).

As per claim 13, Markus discloses the method according to claim 12, wherein said user is connected to said network by a third data processing device (see fig. 2).

As per claim 14, Markus discloses the method according to claim 13, wherein said user uses said third device to access a web page hosted by **said second device**, and wherein the user directs said second device to forward said data request to said first device in order to supply information requested on said web page (see fig. 2 and col. 2, line 65 to col.3, line 10).

As per claim 15, Markus discloses the method according to claim 14, wherein said user provides said second device with the network address of said first device (see col. 1, lines 18-31).

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As per claim 16, Markus discloses a method according to claim 12, wherein said first device generates a verification request to said user in response to the data request being received from said second device (see col. 3, lines 31-39).

As per claim 17, Markus discloses a method according to claim 16, wherein said user is connected to said network by a third data processing device (see fig. 2).

As per claim 18, Markus discloses a method according to claim 17, wherein said verification request is passed from said first device to said third device via the second device (see fig. 3, steps 21-23 and col. 3, lines 31-37).

As per claim 19, Markus discloses A method according to claim 16, wherein said user is based at said second device and wherein the verification is accomplished by means of an interaction between said user and said second device (see fig. 3, steps 21-23 and col. 3, lines 31-37).

As per claim 25, Markus discloses a computer program product in machine readable form containing instructions which when executed cause a computing device to transfer data relating to a user over a communications network by:

a) receiving over said network a request for said data, said request including an identification of one or more pre-defined data elements for which the request is made(see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);

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b) accessing a file containing data relating to the user, said file including data elements identified by data element identifiers and retrieving from said file one or more of said data elements identified in said request (see col. 1, lines 41-46 and col. 3, lines 20-64);;  
and

c) forwarding over said data network to another computing device said retrieved data elements (see col. 3, lines 43-47).

AS per claim 26, Markus discloses a computer program product according to claim 25, further comprising instructions to implement a web browser (see col. 3, lines 20-24).

As per claim 27, Markus discloses a computer program product according to claim 26, wherein said request is in the form of a web page (i.e., document browser) having data entry fields and wherein said browser identifies the data elements required for said fields from tags included in the web page (see col. 2, line 65 to col. 3, line 6 and col. 3, lines 20-24).

As per claim 28, Markus discloses a computer program product according to claim 27, wherein said browser is effective to fill the retrieved data into the corresponding data fields in the web page and to present said web page including said data to said user (see col. 3, lines 20-24).

As per claim 29, Markus discloses a computer program product according to claim 25,



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wherein said instructions are further effective to cause the computing device to identify said user from a plurality of users and to effect an authentication procedure requiring input from said user before forwarding said data elements (see col. 3, lines 31-34).

As per claim 30, Markus discloses a computer program product (computer instruction) in machine readable form containing instructions which when executed cause a computing device ("the second device") to:

- a) receive from a remote computing device ("the third device") an instruction identifying the network address of a further remote computing device ("the first device")(see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);
- b) issue a request for data to said first device, wherein said request includes an identification of one or more pre-defined data elements for which the request is made (see col. 1, lines 41-46 and col. 3, lines 20-64);and
- c) receive from said first device one or more of said identified data items (see col. 3, lines 20-64).

As per claim 31, Markus discloses a computer program product according to claim 30, further effective to cause said second device to forward said data items received from said first device to said third device, and await confirmation that said data items are valid(see col. 3, lines 43-49, where the external entity 13, verifies and corrects the received content and sends the result selective proxy device).

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As per claim 32, Markus discloses a computer program product in machine readable form containing instructions which when executed cause a computing device to:

- a) receive as an input a network address of a remote computing device (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);
- b) forward to said network address a request for data relating to an identified user;
- c) receive from said remote computing device data relating to the user (col. 3, lines 20-64); and
- d) utilize said data in a transaction with the user (see col. 3, lines 20-64).

As per claim 35 Markus discloses a method of obtaining data from a user of a web site, the method comprising:

providing a web page which includes a request for data relating to the user, wherein said request includes a machine readable identification of one or more data items required to complete the transaction(see col. 3, lines 20-64), and receiving from the user one or more of the data items thus identified(see col. 1, lines 18-40), whereby a data processing device (13) associated with the user can provide the requested data items from a stored file containing data relating to the user organized by data item identifiers(see col. 3, lines 20-64).

As per claim 36, Markus discloses an information transfer system comprising:

- a) a communications network (see fig. 2);
- b) first and second data processing devices(14 and 15) connected to said network (see fig. 2);

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c) a storage unit (disk farm) associated with the first device (selective proxy) and containing a plurality of data items relating to a user, in which said data items are organized by data item identifiers (see col. 1, lines 41-58);

d) computer program means associated with the first device which when executed cause the first device to:

- i) determine from a request received from said second device an identification of one or more data items for which the request has been made (see col. 3, lines 20-64);

- ii) retrieve available data items from said storage unit (see col. 3, lines 20-64);  
and

- iii) transmit said data items to said second unit (see col. 3, lines 20-64);

As per claims 37, Markus discloses an information transfer system according to claim 36, further comprising a third data processing device(13) connecting said user to said network, and computer program means associated with said second device which when executed causes said second device to:

- a) receive an instruction from said third device identifying the network address of the first device see fig. 3, col.1, lines 41-46 and col. 3, lines 20-64); and

- b) transmit said request to said first device upon receipt of said instruction see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64);

38. An information transfer system according to claim 37, wherein said computer program means associated with said second device further causes said second device

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to forward said data items received from said first device to said third device (see fig. 3, col. 1, lines 41-46 and col. 3, lines 20-64), whereby said user may issue from said third device to said second device a confirmation signal that the data items are correct (see col. 3, lines 43-49, where the external entity 13, verifies and corrects the received content and sends the result selective proxy device).

As per claim 39, a web site including a web page (document browser) containing a request for data relating to a user of the web site, wherein said web page includes a machine readable identification of one or more pre-defined data items included in said request (i.e., fig. 2, content server 14 and 15 which inherently include web site for serving user requests, the servers contain data related user of the content server) (see col. 2, lines 20-37)

As per claim 40, Markus discloses a web site hosted by a web server on a data network, said web site including a web page containing a request for data relating to a user of the web site, wherein said web page includes an option selectable by a user to cause the web server hosting the page to direct a request for data to a remote computer identifiable by said user. (i.e., fig. 2, content server 14 and 15 which inherently include web site for serving user requests, the servers contain data related user of the content server) (see col. 2, lines 20-37).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 20-24 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Philyaw et al., U.S. Patent No. 6,754,698[hereinafter Philyaw]. As per claim 20, Markus discloses substantial features of the claimed invention as discussed above with respect to claim 19, including the step said user interacting with said second device.

Markus does not disclose wherein said user interacts with said second device at least partially by means of an ID device held by the user and an ID device reader connected to said second device.

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Philyaw discloses a method for accessing a remote location with an optical reader having dedicated memory which includes user identification wherein the said user interacts with said second device at least partially by means of an ID device held by the user and an ID device reader connected to said second device (see fig. 46 and col. 37, lines 1-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to incorporate the teaching of Philyaw such as said user interacting with said second device at least partially by means of an ID device held by the user and an ID device reader connected to said second device into the system of Markus such that Markus remotely located users can be provided simple, low cost ID device such optical reader which can be attached to a personal computer in order to securely access remote locations.

As per claim 21, Philyaw discloses the method according to claim 20, wherein said ID device is selected from a magnetically readable data carrier, an optically readable data carrier, a carrier containing an integrated circuit on which an identification is stored, a device operable to transmit electromagnetic signals to an ID device reader, and a mechanically readable data carrier (see fig. 46 and col. 37, lines 1-16).

As per claim 22, Philyaw discloses a method according to claim 20, wherein said ID device carries a network address of said first device in machine readable format (see fig. 46 and col. 37, lines 1-16 and col. 6, lines 6-24).

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As per claim 23, Philyaw discloses the method according to claim 20, wherein said ID device carries a network address of said first device in human readable format (i.e., URL) (col. 6, lines 6-24).

As per claim 24, Philyaw discloses a method according to claim 20, wherein said ID carrier contains information effective to identify the user to the first machine (col. 6, lines 6-24).

As per claim 33, Markus discloses substantial features of the claimed invention as discussed above with respect to claim 32, including the step said user interacting with said second device.

Markus does not disclose:

wherein said network address is input by means of a reading device reading said address from an ID device held by said user.

Philyaw discloses a method for accessing a remote location with an optical reader having dedicated memory which includes user identification wherein the said user interacts with said second device at least partially by means of an ID device held by the user and an ID device reader connected to said second device (see fig. 46 and col. 37, lines 1-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to incorporate the teaching of Philyaw such as wherein said network address is input by means of a reading device reading said address from an ID device held by said user into the system of Markus such that Markus remotely located

users can be provided simple, low cost ID device such optical reader which can be attached to a personal computer in order to securely access remote locations.

7. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Markus. As per claim 34, Markus discloses substantial features of the claimed invention as discussed above with respect to computer program product according to claim 32, including a computing device (15).

Markus is silent regarding:

wherein said computing device is selected from a hotel check-in terminal, an airline check-in terminal, and a call centre to which the user has a telephony connection.

Nonetheless, selecting said computing device from a hotel check-in terminal, an airline check-in terminal, and a call centre to which the user has a telephony connection would have been modification to Markus system. Furthermore, teaches a client computer 13 can interact with remotely located content/document servers 14 and 15 which may obviously act as a hotel check-in terminal, an airline check-in terminal, and a call centre to which the user has a telephony connection (see fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize Markus's content servers as a hotel check-in terminal, an airline check-in terminal, and a call centre to which the user has a telephony connection, thus ensuring the system scalability.



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### Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 703-308-8441. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should mailed to:**

Box AF

Commissioner of Patents and Trademarks  
Washington, DC 20231

**or faxed to: (703) (872-9306)**

  
Abdullahi Salad

Examiner Au 2157  
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